REMARKS

Claims 1-6 and 8-15 are pending. No new matter has been added by way of the present amendment. For instance, claim 1 has simply been reorganized to provide additional clarity. During the personal interview conducted on September 14, 2006, the Examiner indicated that he would like claim 1 to be reorganized such that each formula (e.g., formula (I), (1), (2) or (3)) is immediately followed by the description thereof. Accordingly, these reorganizing amendments have been submitted. It is noted that these amendments are non-narrowing in nature and do not add new matter.

In view of the following remarks, Applicants respectfully request that the Examiner withdraw all rejections and allow the currently pending claims.

Clarification Concerning Status of Claims

The Examiner has previously indicated that the amendments filed on April 5, 2005 were entered, however, the outstanding Office Action is in conflict with the entry of these amendments. For instance, in the outstanding Office Action the Examiner's rejection under 35 U.S.C. §112, second paragraph refer to limitations which were already cancelled from the claims in the April 5, 2005 Amendment. Regardless of the above, the present set of claims replaces all previous sets of claims. Correct entry on the record is respectfully solicited.

Issues under 35 U.S.C. §112, second paragraph

The Examiner has rejected the claims under 35 U.S.C. §112, second paragraph for the reasons recited at pages 2-3 of the outstanding Office Action. Applicants respectfully traverse this rejection.

As indicated above, the Examiner's rejection references limitations that have already been cancelled from the claims. Regardless, in view of the above amendments Applicants submit that all issues with respect to 35 U.S.C. § 112, second paragraph are moot. Reconsideration and withdrawal thereof are respectfully requested.

Issues under 35 U.S.C. §103(a)

The Examiner has rejected claims 1-14 under 35 U.S.C. §103(a) as being obvious over Ito '084 in view of JP '136 and Adin. Applicants respectfully traverse this rejection.

Applicants hereby incorporate all previously submitted arguments. Moreover, Applicants take this opportunity to highlight the persuasive nature of the Declarative evidence already of record. In particular, Applicants request that the Examiner closely examine the results demonstrated in the Declaration executed by Tetsuo Yamaguchi on July 8, 2004 and submitted with the Response dated July 12, 2004. A review of this Declaration reveals that unexpectedly superior results are achieved by the present invention compared to the cited art. Applicants will highlight some of the significant results demonstrated in the Declaration.

Reviewing the Declaration, Applicants point out that Sample A-1 corresponds to Sample 3 of Ito '084. Sample A-1 was prepared using the materials and procedures of Sample 3 of Ito '084 and thus represents a true replication thereof. Sample A-2 differs by the addition of Compound 95 of JP '136 and Sample A-3 differs by the addition of Compound C-1 of Ito '084. Also, Applicants note that the amounts of Compound C-1 in the Declarative samples are the same as the amounts suggested by Ito '084, for instance, Applicants refer to Samples 5-8 of Ito '084 as shown in Table 23, wherein the added amount was 4.5×10^{-3} mol/Ag. Each of the above Samples represents a comparative showing.

Next, for an Inventive sample, Sample A-4 combines both Compound 95 of JP '136 and Compound C-1 of Ito '084 in the same amounts as individually present in Samples A-2 and A-3, respectively. Thus, in the present instance there does not exist any issues with respect to commensurateness of the declarative evidence. This is due to the fact that the comparative showing need not compare the claimed invention with all of the cited prior art, In re Fenn et al., 208 USPQ 470 (CCPA 1981), but only with the closest prior art. In re Holladay, 199 USPQ 516 (CCPA 1978); see also In re Merchant, 197 USPQ 785 (CCPA 1978); see also In re Wood et al., 202 USPQ 171 (CCPA 1979). In the case of chemical compounds, this means only the compound or compounds closest structurally thereto must be tested. In re Kuderna, 165 USPQ 575 (CCPA 1970). In fact, Applicant is permitted to test compounds which are even more closely related than those of the prior art. Ex parte Humber, 217 USPQ 265 (POBA 1981). Therefore, in the present instance Applicants have used the materials and methods of the primary reference of Ito '084 as a starting point for the comparative showing.

Turning to the results, Applicants draw the Examiner's attention to the results for Dmin (after leaving) in particular. A review of the results reveals that the addition of Compound 95 to Sample A-1 (resulting in Sample A-2) did not result in a change in Dmin (after leaving). Thus, it would be expected that addition of Compound 95 to another Sample would not influence Dmin (after leaving). Next, Applicants note that the addition of Compound C-1 to Sample A-1 (resulting in Sample A-3) resulted in an increase in Dmin (after leaving) of 0.05. Thus, cumulatively, if both Compound 95 and Compound C-1 were combined (resulting in Sample A-4), there would be an expected increase in Dmin (after leaving) of 0.05 compared to Sample A-1.

However, the actual result was a decrease of 0.01 (-0.01). This is a superior Dmin (after leaving) and unexpected in view of the above discussion.

Additionally, the declarative evidence further demonstrates that the increase in sensitivity of Sample A-4 is much higher than the calculated value based on the increase in sensitivity of Sample A-2 and Sample A-3. Moreover, the increase in Dmax of Sample A-4 is higher than the calculated value by 0.1 and the increase in gamma of Sample A-4 is higher than the calculated value by 1, even though Compound 95 shows no effect on Dmax and gamma. Therefore, these results further demonstrate that the present invention exhibits unexpectedly superior results compared to the cited art.

To further aid the Examiner in interpreting the results of the Declaration, Applicants attach hereto Exhibit A. Exhibit A is a chart showing the delta (Δ) results for Dmin, Dmax, Sensitivity, gamma and Dmin (after leaving) for each of Sample A-2, A-3 and A-4 compared to Sample A-1. Exhibit A helps in a better visualization of the unexpectedly superior results according to the present invention. For instance, based upon the design of the Comparative experiments, the Δ for Sample A-4 compared to Sample A-1 would be "expected" to be the additive results of the Δ for Sample A-2 and Sample A-3. However, it is immediately apparent that this is not the case. Rather, the results achieved by Sample A-4 are unexpectedly superior to the results which might have hypothetically been predicted.

Therefore, it is evident that the present invention achieves unexpectedly superior results compared to the prior art. Accordingly, any hypothetical *prima facie* case of obviousness, which Applicants disagree to exist (as supported by the arguments incorporated by reference), is rendered moot. The Examiner is therefore requested to withdraw this rejection.

In view of the above, Applicants respectfully submit that the present application is in condition for allowance. Therefore, the Examiner is requested to withdraw all rejections and allow the currently pending claims.

If the Examiner has any questions or comments, please contact Craig A. McRobbie, Registration No 42,874 at the offices of Birch, Stewart, Kolasch & Birch, LLP.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to our Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. § 1.16 or under § 1.17; particularly, extension of time fees.

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Respectfully submitted,

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Attachment: Exhibit A